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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Application Number	Serial Number	Publication Number	Class	Subclass
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Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003
- 2a) ☒ This action is **FINAL** 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed
- 6) ☐ Claim(s) 1-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) 12 is/are objected to
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that an objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawing(s) are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a) (foreign priority):
- a) ☐ All ☐ Some ☐ None of
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121:

Attachment(s)

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-11 and 13-17 are rejected under 35 U.S.C. 103(a) as obvious over Yanai et al. (US 6,395,353).

The reference discloses a liquid crystal composition containing component I consisting of at least one compound of the compounds (I), component II consisting at least one compound of the compounds (II) and component (III) consisting of at least one compound of the compounds (III-1) and (III-2). The liquid crystal compositions have an appropriate refractive index anisotropy, a low viscosity, a large negative dielectric constant anisotropy, a wide nematic liquid crystal phase range and a high voltage holding rate, while satisfying various properties required for active matrix liquid crystal display devices, and can give display devices with a wide viewing angle.

The reference differs from the claims in that the claims comprising compound (II-30) have a linking group -OCF- instead of -CF-O-. Example 9 of the reference is closest to the present claims 1, 3, 5, 10, 14-15 and 17 (see HCF2OBB(2F, 3F)-O2, 3-HB-O2 and V-III-3). Although the present medium is not exemplified in the reference, the compound (II-41) having a linking group -OCF- is shown on col. 9. Therefore, it would

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have been obvious to those skilled in the art to substitute the compound of (II-41) for (II-30) in Example 9 to arrive at the claimed invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 7-11 and 14-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-12, 14, 16-17 and 19 of US 6,066,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters between the present claims and US '268 overlap each other.

5. The present application has a potential interference with US 6,395,353 if applicant files a certified priority document with English language translation to perfect the priority date (see 37 CFR 1.55(c)(3)).

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Allowable Subject Matter

6. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 2/14/2003 have been fully considered but they are not persuasive. See the double patenting rejection and 103 rejections in this Office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C Wu whose telephone number is 703-308-3956. The examiner can normally be reached on Monday-Friday 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Shean C Wu
Primary Examiner
Art Unit 1756

scw
May 3, 2003